

**REMARKS**

Reconsideration is requested for claims 1-6.

The Official Action noted that certain items identified in the specification were not listed in an Information Disclosure Statement. An Information Disclosure Statement accompanies the present Amendment and cites SCAN-CM 40:94. U.S. Patents corresponding to the cited Finnish documents have been cited previously.

A Request for Approval of Drawing Changes accompanies the present Amendment and adds the legend PRIOR ART to FIGS. 1 and 2.

The Specification was objected to as not including certain optional section headings. Certain of the proposed section headings have been added to the specification. It was asserted that the paragraphs at Page 2, line 24, to Page 3, line 9, discussing FIGS. 1 and 2 should be relocated in the Specification. It is respectfully submitted that the location of this subject matter is appropriate and that there is no statutory or regulatory basis for requiring movement of this subject matter. Withdrawal of the objection is respectfully requested.

Claims 1-5 were rejected under 35 U.S.C. § 112, first paragraph, on grounds of non-enablement because it is alleged that none of the disclosed embodiments teach chips being led to a subsequent process without intermediate storage as the doser 19 is alleged to “store” the chips, if only for a moment or two. While it is respectfully submitted that the rejection is improper as one of ordinary skill in the art would certainly have appreciated what was meant by the claim language. In any event, the claims have been amended to better define the present invention and such that the grounds for the rejection under 35 U.S.C. § 112, first paragraph, is obviated.

Claims 1-6 were rejected under 35 U.S.C. § 112, second paragraph. The claims have been amended to overcome the rejection and withdrawal of the rejection is cordially urged.

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over either U.S. Patent No. 5,203,965 to *McCowan*, WO 84/02093, or what is referred to in the Official Action as “admitted prior art”.

*McCowan* discloses a system wherein sawdust pulp 52 is added to a chip pulp 28 at a paper producing station 30.

Claim 1 recites a combination of steps wherein a desired amount of separated pin chips is dosed among the chips that are to be led to the subsequent process immediately upon being separated from the chips that are to be led to a subsequent process. The claimed method offers advantages including minimizing an amount of equipment necessary to perform the method.

*McCowan* does not disclose a method wherein a desired amount of separated pin chips is dosed among the chips that are to be led to the subsequent process immediately upon being separated from the chips that are to be led to a subsequent process. *McCowan* discloses that before sawdust pulp 52 is added at the paper producing station, it is formed from sawdust separated from chips 20 that are subsequently processed to form the chips 28.

In view of the differences between claim 1 and *McCowan*, and further in view of the advantages available through the claimed method, it is respectfully submitted that claim 1 and the claims dependent therefrom, claims 2-5, define patentably over *McCowan*.

Claim 6 recites a combination of features including at least one separating apparatus adapted to separate pin chips from a quantity of chips to be led to a subsequent process, and a dosing apparatus arranged immediately downstream of the separating apparatus and adapted to dose separated pin chips among the chips that are to be led to the subsequent process as the pin chips are separated by the separating apparatus. The claimed plant offers various advantages including that it requires only minimal equipment and can be inexpensive compared with conventional plants.

*McCowan* does not disclose the claimed combination of features including a dosing apparatus arranged immediately downstream of the separating apparatus and adapted to dose separated pin chips among the chips that are to be led to the subsequent process as the pin chips are separated by the separating apparatus. As sawdust is separated from chips 20 in *McCowan*, it is first processed to form sawdust pulp 52 before being added to the processed chips 28 at the paper production station.

In view of the differences between claim 6 and *McCowan*, and further in view of the advantages available through the claimed plant, it is respectfully submitted that claim 6 defines patentably over *McCowan*.

With respect to WO 84/02093, the disclosed process and apparatus is not seen to have any step or structure for dosing separated pin chips. It is understood that undersized chips are all directed to chain 34 and not reintroduced into the chips to be processed. Whether the screen 54 passes chips to a digester without intermediate storage is not understood to have any relevance to the present invention. It is respectfully submitted that

claims 1-6 all define patentably over WO 84/02093 and withdrawal of the rejection is cordially urged.


With respect to what is referred to as admitted prior art, it is respectfully submitted that the admitted prior art does not disclose the method of claims 1-5 wherein a desired amount of separated pin chips is dosed among the chips that are to be led to the subsequent process immediately upon being separated from the chips that are to be led to a subsequent process, or the plant of claim 6 including at least one separating apparatus adapted to separate pin chips from a quantity of chips to be led to a subsequent process, and a dosing apparatus arranged immediately downstream of the separating apparatus and adapted to dose separated pin chips among the chips that are to be led to the subsequent process as the pin chips are separated by the separating apparatus. Withdrawal of the rejection based on what is referred to as admitted prior art is cordially urged.

It is respectfully submitted that all of the pending claims, claims 1-6, define patentably over the cited references and are in condition for allowance. Allowance is cordially urged.

If the Examiner should be of the opinion that a telephone conference would be helpful in resolving any outstanding issues, the Examiner is urged to contact the undersigned.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
Harold R. Brown III  
Registration No. 36,341

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: Jan 3, 2002

**IN THE SPECIFICATION:**

Kindly amend the specification as follows:

Page 1, line 2, insert:

**BACKGROUND AND SUMMARY**

Delete the paragraph at Page 1, lines 29-30.

Page 2, line 8, insert:

**BRIEF DESCRIPTION OF THE DRAWINGS**

Page 2, line 23, insert:

**DETAILED DESCRIPTION**

## IN THE CLAIMS

Amend the claims as follows:

1. (Amended) A wood chip screening method [wherein the] comprising:  
separating, in a separating apparatus, pin chips [(9) are separated from the rest of  
the] from a quantity of chips [and dosed] that are to be led to a subsequent process;  
dosing a desired amount of the separated pin chips among the chips that are to be led  
to a subsequent process [(7)] so that [the] a share of [the] dosed pin chips [(9)] relative to  
[the] a total amount of chips [(7)] does not exceed a desired value, [characterised in that a]  
wherein the desired amount [(20)] of the separated pin chips [separated in the  
screening process, once the screening process has been completed, is led] is dosed among  
the chips that are to be led to the subsequent process [(7) without intermediate storage]  
immediately upon being separated from the chips that are to be led to a subsequent process.

2. (Amended) A chip screening method as defined in claim 1, [characterised in  
that] wherein a dosing apparatus doses the desired amount of pin chips [(20) led among the  
chips that are to be led to the subsequent process (7) is defined by means of a dosing  
apparatus (19, 19', 26, 28)].

3. (Amended) A chip screening method as defined in claim 1, [characterised in  
that] wherein the desired amount of pin chips [(20) led] dosed among the chips that are to  
be led to the subsequent process [(7) is defined by measuring the] is a function of an  
amount of chips [(2) fed into the screening process] separated in the separating apparatus.

4. (Amended) A chip screening method as defined in claim 1, [characterised in that] wherein the desired amount of pin chips [(20)] dosed among the chips that are to be led to the subsequent process is [defined by measuring the] is a function of an amount of chips fed into the subsequent process [(7) from the screening process].

5. (Twice Amended) A chip screening method as defined in claim 1, [characterised in that the amount of] comprising leading separated pin chips [(21)] exceeding the desired amount [(20) is led among the sawdust or to the chip pile preceding the screening process or to a separate pin pile] of pin chips to a remote location.

6. (Amended) A plant for screening wood chips and for subsequently leading [them] chips to a subsequent process [(7), which plant comprises one or more] comprising:  
[screening devices (1, 18) and means for dosing the] at least one separating apparatus adapted to separate pin chips from a quantity of chips to be led to a subsequent process; and

a dosing apparatus arranged immediately downstream of the separating apparatus and adapted to dose separated pin chips [(9)] among the chips [(7)] that are to be led to the subsequent process as the pin chips are separated by the separating apparatus [, characterised in that the means (19, 19', 26, 28) for dosing the pin chips (9) among the chips (7) that are to be led to the subsequent process are placed immediately after the screening devices (1, 18) or the conveyors (27, 29) coming therefrom].